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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,675	10/28/1999	KRIS R LIVINGSTON	10991673-1	7615

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HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/430,675

**Applicant(s)**

LIVINGSTON, KRIS R

**Examiner**

Mark E. Wallerson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30 and 33-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Part III DETAILED ACTION**

***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on 2/15/05.
2. This application has been reconsidered. Claims 30 and 33-35 are pending.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 30, the limitation “*partitioning the plurality of pages of data into a plurality of sets, individual of the plurality of sets including up to the multiple of the pages of data*” disclosed in lines 11 and 12 of claim 30 is indefinite and unclear.

With respect to claim 30, the limitation “*forming images on the media using the second imaging device for ones of the plurality of sets having none of the included pages of data including only the data corresponding to the text*” disclosed in lines 16-18 of claim 30 is indefinite and unclear.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 30 is rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al (Roberts) (U.S. 6,650,431).

With respect to claim 30 as best understood by the Examiner, Roberts discloses a method for forming images on media using a plurality of pages of data (column 6, lines 40-48), comprising selecting a first imaging related option (black and white or monochromatic) (column 9, lines 16-33) to form images on the media using N of the plurality of pages of data on individual pages of the data (which reads on printing a page of the document (assuming that N=1)) (column 6, lines 49-55); selecting a second imaging related option (color) to form images on the media using a first imaging device (110) having a capability to form the images on the

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media at a first resolution (which reads on the color pages) for pages including images corresponding to pictures (graphics or pie-charts) (column 1, lines 29-45), and using a second imaging device (112) having a capability to form images on the media at a resolution less than the first resolution (which reads on black and white pages) (column 6, lines 49-63) for ones of the plural pages of data having data including only text (column 1, lines 29-45); partitioning the plurality of pages into a plurality of sets (the abstract, lines 1-5); forming images on the media using the first imaging device for ones of the plurality of sets (the color pages) and forming images using the second imaging device for ones of the plurality of sets having none of the included pages of data including the pages of data including only the data corresponding to the text (the black and white pages) (the abstract).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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8. Claims 33-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato (U.S. 5,978,557).

With respect to claims 33-35, Kato discloses identifying ones of plural pages having data of a first characteristic (monochromatic) and ones of the plural pages having a second characteristic (color) (column 5, lines 4-15); sending the plural pages to a first imaging device (2000 or 21) capable of forming the images on the media for the pages having the first characteristic (column 5, lines 4-15); including blank pages (replacement pages) corresponding to the ones of the plural pages (column 5, line 4 to column 6, line 59, column 7, lines 11-17, and column 9, line 52 to column 10, line 4); sending the plurality of pages to a second imaging device capable of forming images on the media for the plural pages having the second characteristic (column 5, line 4 to column 6, line 59), and forming the images on the blank units of the media using the second imaging device (column 2, lines 11-17 and column 9, line 52 to column 10, line 4).

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 30 and 33-35 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470.

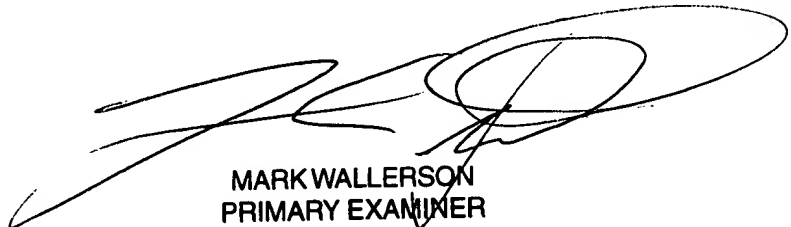
The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
Primary Examiner  
Art Unit 2626



MARK WALLERSON  
PRIMARY EXAMINER